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EXAMINER				
DEGA, MURALI K				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/777,904

Applicant(s)

HIRAI ET AL.

Examiner

Murali K. Dega

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) None is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This office action is in response to the applicant's arguments filed on 11 September 2008.
2. Claims 1-12 are currently pending and have been examined.

Claim Rejections - 35 USC § 112 – Second paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9 and 11 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with functional or operational language such as "agreement or disagreement of said combinations...". A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (MPEP § 21114).

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The term "a combination of any of them" in claim 3 is an optional term which renders the claims indefinite. The term "a combination of any of them" is not defined by the claim, the specification does not provide a standard for ascertaining the number of

combinations or a specific combination, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al (US 5,412,718) herein after referred to as Narasimhalu, in view of Ogino et al (US 7,031,942) herein after referred to as Ogino.

9. With respect to claim 1:

10. Narasimhalu discloses a contents copying management system configured by connecting a contents copying apparatus and a copying management device by way of a network:

- Medium identifying information acquiring means for acquiring medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium ("unique signature of a given storage medium", Abstract, Fig. 6A, step 90, "using a medium signature is presented", col. 3, ll. 17-19, "reads the storage medium's identification", col. 6, ll. 22-25).

- Apparatus identifying information acquiring means for acquiring apparatus identifying information specific to and indicating said contents copying apparatus itself ("Restricting the usage.... By verifying the device ID", Abstract, col. 2, ll.34-38 and col. 7, ll. 7-12).
- Copying-related combination information transmitting means for transmitting said medium identifying information and said apparatus identifying information to said copying management device as copying-related combination information at the time of copying said contents (Fig. 6A, step 80 and step 90 resulting in step 100).
- Copying authorizing information generating means for comparing said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said memory means in advance ("generating a key from both the signature of the medium and the device ID". Col. 2, ll. 34-39), judging agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, generating copying authorizing information for authorizing an operation of copying the contents in response to agreement of said combinations but generating copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations.

- Narasimhalu discloses use of unique medium signature identification in combination with device identification. But Narasimhalu does not explicitly describe the copying device. However, Ogino teaches receiving means for receiving copying authorizing information generated by said copying management device on the basis of said copying-related combination information at the time of accessing said copying management device (Col. 1, ll. 41-53 and col. 3, ll. 21-37, where copy generation management system is described which can represent whether copying is prohibited, whether one copy can be made or permit unrestricted copying).
- Narasimhalu discloses use of unique medium signature identification in combination with device identification. But Narasimhalu does not explicitly describe the control steps. However, Ogino teaches Control means for controlling the operation of copying said contents in response to said copying authorizing information (Abstract, figs. 1 & 10, col. 1, ll. 41-53, col. 2, ll. 19-21, col. 8, ll. 54-63, claims 1, 3, 5 and 14 where the function of a copy controller is exhaustively discussed in terms of permitting or prohibiting copying of content and notifying users in a positive manner).
- Narasimhalu discloses use of unique medium signature identification in combination with device identification. But Narasimhalu does not explicitly describe the copying management device. However, Ogino teaches Copying management device comprising: memory means for registering and storing said copying-related combination information received from

said contents copying apparatus in advance (Abstract, figs. 1 & 10, col. 1, ll. 22-53, col. 2, ll. 28-40, col. 6, ll. 30-40, col. 6, ll. 50-58, col. 7, ll. 8-26, col. 8, ll. 6-14, where the functions of a copy controller are discussed in terms of copy control information extraction, encrypted flag information, decryption using master key data stored, disc key data and title key data, and finally the copy controller either permitting the copying or prohibiting the copying).

- Narasimhalu discloses use of unique medium signature identification in combination with device identification. But Narasimhalu does not explicitly describe the copying apparatus. However, Ogino teaches copying authorizing information transmitting means for transmitting said copying authorizing information to said contents copying apparatus (Fig. 7 and 10, step 52).
- It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the system of Narasimhalu to include copying apparatus details and other devices as per the teachings of Ogino in developing a method for copying, for the purposes of preventing unauthorized copying of the medium contents, with neither undue experimentation nor unexpected results.

11. With respect to claim 2:

12. Ogino discloses controlling reproduction of said copied contents according to said copying authorizing information ("copy control information", Abstract, figs. 1 & 10,

col. 1, ll. 41-53, col. 2, ll. 19-21, col. 8, ll. 54-63, claims 1, 3, 5 and 14 where the function of a copy controller is exhaustively discussed in terms of permitting or prohibiting copying of content and notifying users in a positive manner).

13. With respect to claim 3:

14. Narasimhalu discloses medium identifying information is dispersion of the printing surface of said recorded-contents-carrying original recording medium produced at the time of printing, dispersion information of the signals on the recording surface of said recorded-contents-carrying original recording medium, the signals recorded on the recording surface or a combination of any of them ("unique signature of a given storage medium", Abstract, Fig. 6A, step 90, "using a medium signature is presented", col. 3, ll. 17-19, "reads the storage medium's identification", col. 6, ll. 22-25).

15. With respect to claim 4:

16. Ogino discloses controlling copying of said contents according to said copying authorizing information and displays a predetermined warning image on display means when copying is not authorized according to said copying authorizing information (Abstract, figs. 1 & 10, col. 1, ll. 41-53, col. 2, ll. 19-21, "displaying an attention message", col. 8, ll. 15-63, claims 1, 3, 5 and 14 where the function of a copy controller is exhaustively discussed in terms of permitting or prohibiting copying of content and notifying users in a positive manner).

17. With respect to claim 5:

18. Ogino discloses memory that registers said medium identifying information according to the title of said contents on a title by title basis when registering and storing

in advance said copying-related combination information received from said contents copying apparatus and said copying authorizing information generating means selects said medium identifying information to be compared according to said title when it compares said copying-related combination information received at the time of said access of said contents copying apparatus with said copying-related combination information registered in advance in said memory means (Col. 6, ll. 59-67, col. 12, ll. 8-26 and col. 15, ll. 11-31, where to obtain a detection output, utilization of de-spreading process, PN code string, copy control information and copy control information being same as prior to performance of spreading process).

19. With respect to claim 6:

20. Ogino discloses control generating the contents to be copied, convoluting said medium identifying information and said apparatus identifying information into said contents, when copying said contents and controls reproduction of said copied contents by taking out the medium identifying information and the apparatus identifying information from said copied contents, transmitting the combined information to said copying management device by means of said copying-related combination information transmitting means and receiving said copying authorizing information generated by said copying management device on the basis of the combination of the medium identifying information and apparatus identifying information by the receiving means when reproducing said copied contents (Abstract, figs. 1 & 10, col. 1, ll. 41-53, col. 2, ll. 19-21, col. 8, ll. 54-63, claims 1, 3, 5 and 14 where the function of a copy controller is

exhaustively discussed in terms of permitting or prohibiting copying of content and notifying users in a positive manner).

21. With respect to claim 7:

22. Ogino discloses control generating the contents to be copied, convoluting said medium identifying information and said apparatus identifying information into said contents and additionally stores the medium identifying information and the apparatus identifying information in said recording/reproducing apparatus when carrying out an operation of copying said contents and it confirms if said copied contents are authorized to be copied according to the copying authorizing information obtained by taking out the medium identifying information and the apparatus identifying information, transmitting the combined information to said copying management device by means of said copying-related combination information transmitting means and receiving said copying authorizing information generated by said copying management device on the basis of the combination of the medium identifying information and apparatus identifying information by the receiving means when the copied contents are not reproduced (Abstract, figs. 1 & 10, col. 1, ll. 41-53, col. 2, ll. 19-21, col. 8, ll. 54-63, claims 1, 3, 5 and 14 where the function of a copy controller is exhaustively discussed in terms of permitting or prohibiting copying of content and notifying users in a positive manner).

23. With respect to claim 8:

24. Ogino discloses control encoding the contents, using said apparatus identifying information as key, when carrying out an operation of copying said contents (Abstract, col. 2, ll. 28-42 and col. 3, ll. 3-20, where the functions of a copy controller are

discussed in terms of copy control information extraction, encrypted flag information, decryption using master key data stored, disc key data and title key data, and finally the copy controller either permitting the copying or prohibiting the copying).

25. With respect to claim 9:

26. Ogino discloses copying management device:

- Receiving means for receiving medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium and apparatus identifying information specific to and indicating a contents copying apparatus itself from said contents copying apparatus as copying-related combination information at the time of copying said contents by way of a network (Col. 1, ll. 41-53 and col. 3, ll. 21-37, where copy generation management system is described which can represent whether copying is prohibited, whether one copy can be made or permit unrestricted copying).
- Memory means for registering and storing said copying-related combination information received from said contents copying apparatus in advance (Abstract, figs. 1 & 10, col. 1, ll. 22-53, col. 2, ll. 28-40, col. 6, ll. 30-40, col. 6, ll. 50-58, col. 7, ll. 8-26, col. 8, ll. 6-14, where the functions of a copy controller are discussed in terms of copy control information extraction, encrypted flag information, decryption using master key data stored, disc key data and title key data, and finally the copy controller either permitting the copying or prohibiting the copying).

- Copying authorizing information generating means for comparing said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said memory means in advance, determining agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, generating copying authorizing information for authorizing an operation of copying the contents in response to agreement of said combinations but generating copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations (Abstract, figs. 1 & 10, col. 1, ll. 22-53, col. 2, ll. 28-40, col. 6, ll. 30-40, col. 6, ll. 50-58, col. 7, ll. 8-26, col. 8, ll. 6-14, where the functions of a copy controller are discussed in terms of copy control information extraction, encrypted flag information, decryption using master key data stored, disc key data and title key data, and finally the copy controller either permitting the copying or prohibiting the copying).
- Copying authorizing information transmitting means for transmitting said copying authorizing information to said contents copying apparatus, wherein said copying management device controlling copying of said contents by said contents copying apparatus from said recorded-contents-carrying original recording medium according to said copying authorizing information with respect to each recorded-contents-carrying original

recording medium (Col. 1, ll. 41-53 and col. 3, ll. 21-37, where copy generation management system is described which can represent whether copying is prohibited, whether one copy can be made or permit unrestricted copying).

27. With respect to claim 10:

28. Ogino discloses copying management method"

- A copying-related combination information receiving step of receiving medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium and apparatus identifying information specific to and indicating a contents copying apparatus itself from said contents copying apparatus as copying-related combination information at the time of copying said contents by way of a network (Col. 1, ll. 41-53 and col. 3, ll. 21-37, where copy generation management system is described which can represent whether copying is prohibited, whether one copy can be made or permit unrestricted copying).
- A storing step of registering and storing said copying-related combination information received from said contents copying apparatus in advance (Abstract, figs. 1 & 10, col. 1, ll. 22-53, col. 2, ll. 28-40, col. 6, ll. 30-40, col. 6, ll. 50-58, col. 7, ll. 8-26, col. 8, ll. 6-14, where the functions of a copy controller are discussed in terms of copy control information extraction, encrypted flag information, decryption using master key data stored, disc

key data and title key data, and finally the copy controller either permitting the copying or prohibiting the copying).

- A copying authorizing information generating step of comparing said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said memory step in advance, determining agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, generating copying authorizing information for authorizing an operation of copying the contents in response to agreement of said combinations but generating copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations (Abstract, figs. 1 & 10, col. 1, ll. 22-53, col. 2, ll. 28-40, col. 6, ll. 30-40, col. 6, ll. 50-58, col. 7, ll. 8-26, col. 8, ll. 6-14, where the functions of a copy controller are discussed in terms of copy control information extraction, encrypted flag information, decryption using master key data stored, disc key data and title key data, and finally the copy controller either permitting the copying or prohibiting the copying).
- A copying authorizing information transmitting step of transmitting said copying authorizing information to said contents copying apparatus, wherein said copying management method controlling copying of said contents by said contents copying apparatus from said recorded-contents-

carrying original recording medium according to said copying authorizing information with respect to each recorded-contents-carrying original recording medium (Col. 1, ll. 41-53 and col. 3, ll. 21-37, where copy generation management system is described which can represent whether copying is prohibited, whether one copy can be made or permit unrestricted copying).

29. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al (US 5,412,718) herein after referred to as Narasimhalu, in view of Ogino et al (US 7,031,942) as applied to claims 1-10 above, and further in view of Hars (US 7,302,575).

30. With respect to claims 11 and 12:

31. Narasimhalu discloses contents copying apparatus:

- medium identifying information acquiring means for acquiring medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium ("unique signature of a given storage medium", Abstract, Fig. 6A, step 90, "using a medium signature is presented", col. 3, ll. 17-19, "reads the storage medium's identification", col. 6, ll. 22-25).
- An apparatus identifying information acquiring means for acquiring apparatus identifying information specific to and indicating said contents copying apparatus itself ("Restricting the usage.... By verifying the device ID", Abstract, col. 2, ll.34-38 and col. 7, ll. 7-12).

- copying-related combination information transmitting means for transmitting said medium identifying information and said apparatus identifying information to a copying management device connected to it by way of a network as copying-related combination information at the time of copying said contents (Fig. 6A, step 80 and step 90 resulting in step 100). But neither Narasimhalu nor Ogino explicitly mention transmission over a network. However, Hars teaches (Fig. 1, item 22) media content and the copy control information transmitted over a network such as internet.
- It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the system of Narasimhalu and Ogino to include use of public or private networks as per the teachings of Hars in developing a method for content and copying information transmission over a network, for the purposes of wider reach, with neither undue experimentation nor unexpected results
- Narasimhalu discloses use of unique medium signature identification in combination with device identification. But Narasimhalu does not explicitly describe the copying device. However, Ogino teaches receiving means for receiving copying authorizing information generated by said copying management device on the basis of said copying-related combination information at the time of accessing said copying management device (Col. 1, ll. 41-53 and col. 3, ll. 21-37, where copy generation management

system is described which can represent whether copying is prohibited, whether one copy can be made or permit unrestricted copying).

- Narasimhalu discloses use of unique medium signature identification in combination with device identification. But Narasimhalu does not explicitly describe the control steps. However, Ogino teaches Control means for controlling the operation of copying said contents in response to said copying authorizing information (Abstract, figs. 1 & 10, col. 1, ll. 41-53, col. 2, ll. 19-21, col. 8, ll. 54-63, claims 1, 3, 5 and 14 where the function of a copy controller is exhaustively discussed in terms of permitting or prohibiting copying of content and notifying users in a positive manner).

Examiner Note

32. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

33. The USPTO interprets claim limitations that contain statements such as “*if, may, might, can, could, when, potentially, possibly*”, as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, **optional claim elements do not narrow claim limitations**, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

34. The following are examples of recitations that have been considered but given less patentable weight because they fail to add any steps/structure and are thereby regarded as intended use language:

- “at the time of accessing” in claim 1,
- “a combination of any of them” in claim 3, and
- “registered in advance in said memory” in claim 5.

The above are examples only and are not an exhaustive listing of the intended use language in the claims. To be especially clear, the Examiner has considered all claim limitations. However, the recitation of intended use of the claimed invention must result in additional steps/structure in order to further limit the claims. Where possible, in order to advance prosecution, the Examiner has addressed these limitations in anticipation of Applicant amending the claims to positively recite these limitations.

Response to Arguments

35. Applicant's arguments with respect to the prior art's application to claims 1 - 12 have been considered but are moot in view of new ground(s) of rejection.

Conclusion

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- All additional references cited relate to various illegal copying of digital media prevention systems that are at least generally applicable to the disclosed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Murali K Dega/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
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